

11-04-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #70

**IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE BEFORE THE TRADEMARK  
TRIAL AND APPEAL BOARD**

Prairie Island Indian Community,  
a federally recognized Indian Tribe,

Petitioner

vs.

Treasure Island Corporation,

Registrant.

Reg. Nos. 1,949,380; 1955,279  
2,010,396; 2,176,004; 1,984,421  
2,040,221; 2,019,481; 1,918,033  
1,941,475; 1,966,090; 1,903,619  
1,943,123; 1,949,379; 1,985,968  
2,040,756; 2,040,770; 1,981,369

Can.Nos. 28,126; 28,127; 28,130  
28,133; 28,145; 28,155; 28,199  
28,248; 28,280; 28,294; 28,314  
28,319; 28,325; 28,342; 28,379  
28,171; 28,174  
Opposition No. 115,866

**PETITIONER'S RESPONSE TO MOTION TO COMPEL PRODUCTION OF  
DOCUMENTS, TO DEFINE SCOPE OF THE WAIVER OF ATTORNEY  
CLIENT PRIVILEGE AND TO EXTEND DISCOVERY**

**I. INTRODUCTION AND SUMMARY OF RESPONSE**

The Registrant, Treasure Island Corporation (TIC) has filed with the Board a Motion seeking 1) to compel production of documents from third party Dorsey & Whitney LLP; 2) to "define" the scope of the waiver of attorney client privilege previously defined by the Board in its May 13, 2002 Order; and 3) to extend discovery. In addition TIC asserts arguments about whether attorney William Hardacker should be made to appear for a deposition.

None of TIC's requests are properly before the Board. First, TIC's motion to compel production of documents seeks an order of this Board compelling production from a third party, Dorsey & Whitney, LLP, which produced documents and a privilege log pursuant to a Federal Court subpoena. This Board lacks jurisdiction over the

sufficiency of federally-subpoenaed production, and any challenge to that production must be, and has not been, brought before the issuing federal court.

Second, TIC's motion to "define" the Board's May 8, 2002 Order (the Board's Order) regarding the scope of the waiver of the attorney/client privilege in this matter is an untimely and improper motion for reconsideration that this Board should not entertain. Moreover, the Board's Order is clear and unequivocal and needs no definition or clarification.

Third, the Board need not order the extension of discovery, since the Prairie Island Indian Community (the Community) is and has been willing to stipulate to such an extension, and so TIC's motion in this respect is improper based on its failure to attempt to secure its requested relief from the Community and without Board involvement.

Fourth, TIC's Motion with respect to the deposition of William Hardacker is also improper. Mr. Hardacker, like Dorsey & Whitney, LLP, is a third party witness that has been served a deposition subpoena issued from the United States District Court for the District of Minnesota. This Board lacks any jurisdiction either to compel Mr. Hardacker's attendance at that deposition or to control the effect of the Federal Court subpoena. Nevertheless, TIC's motion is also improper because it is based on the false premise that the Community believes Mr. Hardacker to be immune from deposition based on the attorney/client privilege. That is simply untrue, and neither the Community nor Mr. Hardacker objected to his deposition once he had been duly subpoenaed. Finally, TIC's motion regarding Mr. Hardacker is moot, since they elected, the day before the deposition, to postpone it indefinitely.

## II. FACTUAL AND PROCEDURAL SUMMARY

On September 8, 1999, the Community voluntarily disclosed in discovery two letters between Merchant & Gould attorney Gregory Sebald and the Community, which disclosed communications that were otherwise protected by the attorney/client privilege. The parties thereafter could not agree on the scope of the waiver effected by that disclosure, with the Community contending that it had properly limited the disclosure to communications between the same attorney and the same client on the same subject matter, and TIC contending that the disclosure effected a waiver as to all other privileged communications regarding the TRESAURE ISLAND mark.

On April 25, 2001, TIC filed a motion to compel with the Board. In support of its Motion, TIC argued in its Briefs that the waiver should extend to "all correspondence 'from Merchant & Gould (plaintiff's former counsel) regarding the TREASURE ISLAND mark'". See, Board's Order at 11.

On May 11, 2001, the Community filed a responsive brief and acknowledged the voluntary waiver of privilege, but argued that the waiver extended "only as to 'the subject matter of the disclosed communications – the registrability of the Plaintiff's mark in 1992'". See, Board's Order at 11. The Community also submitted to the Board for *in camera* review 8 documents that were the subject of TIC's Motion.

On May 8, 2002, the Board issued its Order on TIC's Motion, and other matters, and held as follows regarding the scope of the Community's voluntary waiver of the attorney/client privilege:

Thus the issue before the Board now is not whether plaintiff waived its attorney-client privilege, which has been conceded, but the scope of the waiver.

The voluntary waiver by a party, without limitation, of one or more privileged documents discussing a certain subject waives the privilege as to all communications between the same attorney and the same client on the same subject. The authorities for this general rule are numerous. See e.g., Weil v. Investment/Indicators, Research & Management, 647 F.2d 18, 24 (9<sup>th</sup> Cir. 1981) and, in general, 4 Moore's Federal Practice ¶26.60[2], page 26-201-2-2 (1989).

Board's Order at 10-11.

Neither party sought reconsideration of the Board's May 8, 2002 Order, and the parties have subsequently engaged in discovery pursuant to the Board's Order, including written discovery and depositions.

On September 30, 2002 the Community received the instant Motion in which TIC argues, as it did in April of 2001, that the Community's waiver of the attorney/client privilege extends "to all communications on the same subject", apparently meaning that it now seeks an Order of the Board deleting the "same attorney" and "same client" requirements specifically adopted by the Board's Order.

### **III. DISCUSSION**

#### **A. THE BOARD SHOULD REJECT TIC'S MOTION TO "DEFINE" THE BOARD'S ORDER REGARDING THE SCOPE OF THE WAIVER OF PRIVILEGE IN THIS MATTER.**

##### **1. TIC's Motion For Reconsideration of the Board's Order Should Be Stricken as Untimely.**

TIC filed the instant motion on September 30, 2002, in relevant part, "to define the scope of the waiver of the attorney-client privilege" based on the Community's voluntary disclosures of two documents. *See* Registrants' [sic] Motion To Compel Production Of Documents, to Define Scope of the Waiver of the Attorney - Client

Privilege, and to Extend Discovery. (hereinafter "TIC's September 30<sup>th</sup> Motion"). The Registrant also asked the Board to "clarify" the scope of the Board's Order regarding the limited waiver of attorney-client privilege. *See, Id.* at 11. In its prayer for relief, the Registrant asked the Board to "enter an order" that differs substantively and materially from the Board's Order. *See Id.* at 20. Although couched in terms of "define" and "clarify," TIC's characterization of its motion is merely a guise for its request to change the substance of its Order; in essence, a motion to reconsider.

The Board's Order examined "not whether plaintiff waived its attorney-client privilege, ... but the scope of the waiver." *See Board's Order* at 11. The Board evinced the standard that a "voluntary waiver by a party, without limitation, of one or more privileged documents discussing a certain subject waives the privilege as to all communication between the same attorney and the same client on the same subject." *See Id.* at 12. The Board next applied this standard to a series of documents between the same attorney and the same client or client's representative, to determine whether the communications touched on the same subjects.

TIC's September 30<sup>th</sup> Motion asks the Board to reconsider its May 8, 2002 Order and to issue a *new* order altering the Board's waiver standard. TIC's September 30<sup>th</sup> Motion, however, is untimely. "Any request for reconsideration or modification of an order or decision on a motion must be filed within one month from the date thereof." *See* 37 C.F.R. § 2.127 (b), *see also Avedis Zildjian Co. v. D.H. Baldwin Co.*, 181 U.S.P.Q. 736 (1974) (stating that "[t]he applicable period for seeking reconsideration from a decision of the Trademark Trial and Appeal Board is thirty days from the date of the decision."). The Board issued its Order regarding the scope of attorney-client waiver on

May 8, 2002. Under the TTAB's Rules of Procedure, TIC's motion for reconsideration, in order to be considered timely, should have been filed by June 10, 2002. TIC did not, however, file its motion for reconsideration within this time frame. Instead, TIC waited almost five months before filing its motion to "clarify." Because TIC's September 30<sup>th</sup> Motion to reconsider is late by four months, it should be stricken as untimely.

Although the Board may, in its discretion, consider an untimely request for reconsideration or modification, *see Avedis Zildjian*, TIC has not demonstrated why the Board's Order should be reconsidered.

The TBMP clearly provides that "the premise underlying a motion for reconsideration, modification or clarification ... is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued." Rule 518, TBMP. The Board requires that the party seeking reconsideration make a "demonstration that, based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change." *Id.*, *see also Paskon v. Slaem Memorial Hosp. Dist.*, 806 S.W.2d 417, 424 (Mo. Ct. App. 1991)(stating that a motion for rehearing shall briefly and distinctly state the grounds upon which rehearing is sought), and *Simmons v. Interstate Commerce Comm'n*, 760 F.2d 126, 132 (7<sup>th</sup> Cir. 1985)(stating that anyone who files a petition to reopen a decision has the burden of persuading the tribunal that reopening is warranted).

Here, TIC has not set forth any underlying set of facts or authorities to support its motion for reconsideration. TIC has not demonstrated that the Board's Order was in error, has not advanced any new theory, law, or evidence supporting its untimely motion,

nor offered any excuse for its failure to ask for reconsideration or clarification of the Order when issued.

TIC's purported confusion regarding the meaning of the Board's Order cannot excuse its failure to seek rehearing within the appropriate time frame. *See also ANR Pipeline Co. v. Federal Energy Regulatory Comm'n*, 988 F.2d 1229, 1234 (D.D.C. 1993) (holding that ANR's uncertainty as to which potential interpretation of an agency order was the correct one, even if justifiable, did not excuse its failure to ask for rehearing or clarification of that order when issued). TIC has not argued that the Board's Order is ambiguous, subject to more than one interpretation, or unsupported by law. TIC, instead, attempts to reargue issues determined by the challenged Board Order – the scope of Prairie Island's waiver of attorney-client privilege. Therefore, TIC's September 30<sup>th</sup> Motion is nothing more than an untimely and impermissible attempt to revisit issues that the Board addressed previously in the Board's Order. Prairie Island requests that the Board strike TIC's September 30<sup>th</sup> Motion as untimely.

**2. TIC's Motion Should Be Denied Because The Board's Order Is Clear And Unequivocal And Needs No Clarification Or "Definition".**

Even if the Board was to entertain TIC's untimely motion for reconsideration, the Motion should be denied because the Board's Order needs no further explanation. It is clear on its face.

At page 12 of that Order, the Board states the controlling standard on the issue:

The voluntary waiver by a party, without limitation, of one or more privileged documents discussing a certain subject waives the privilege as to all communications between the same attorney and the same client on the same subject. The authorities for this general rule are numerous. See e.g., Weil v. Investment/Indicators, Research & Management, 647 F.2d

18, 24 (9<sup>th</sup> Cir. 1981) and, in general, 4 Moore's Federal Practice ¶26.60[2], page 26-201-2-2 (1989).

The Board then reviewed in camera the 8 documents that were the subject of TIC's Motion, and determined that the privilege as between Gregory Sebald and the Community had been waived with respect to the following subject areas:

- 1) "review of trademark availability search results." Order at p. 13;
- 2) "counsel's request for plaintiff's dates of first use". Order at p. 14;
- 3) "plaintiff's intention to initiate an advertising campaign". Order at 14 and
- 4) "plaintiff's intention for filing for "state service mark registrations." Order at 14.

TIC now asks this Board to alter its ruling, though stating it as a request to "define" or "clarify" the scope. The scope of the Board's Order is clear and needs no further explanation. The Board's ruling extends to communications between Merchant & Gould attorney Gregory Sebald and the Community regarding the four areas identified above. As stated above, TIC has utterly failed to identify how the Board's Order is in any way unclear, and is unconvincing in its effort to create ambiguity in the Order where it does not exist.

**3. TIC's Selective Focus On the Subject Matter Element of the Board's Order Completely Ignores the Plain Language Of the Board's Order as a Whole.**

TIC requests "definition" of the Board's Order, but never identifies what about the Order is in need of definition or clarification. Nevertheless, in an apparent effort to create an ambiguity where it does not exist, TIC disregards the plain language of the Order and instead offers a selective interpretation in support of its position. Such

discriminatory adoption and application of the Board's Order cannot support Defendant's crabbed reading of the scope of Prairie Island's waiver as defined in the Board's Order

In its Order, the Board held that "the issue before the Board ... is not whether plaintiff waived its attorney-client privilege, which has been conceded, but the scope of the waiver." See Board's Order at 11. The Board stated next that "[t]he voluntary waiver by a party, without limitation, of one or more privileged documents discussing a certain subject waives the privilege as to all communications between the same attorney and the same client on the same subject." See *Id* at 12. Under the Board's holding, if a party voluntarily discloses privileged information, the party has waived the privilege to other communications if three factors are satisfied: if the communications concern 1) the same attorney; 2) the same client; and 3) the same subject matter. See *id*; see also *Emhart Indus., Inc. v. Sanko Seiki Mfg. Co.*, 1986 WL 13515 (N.D. Il. 1986)(stating the settled principle that if a client chooses to disclose, without limitation, a privileged communication, he waives the privilege as to all communications between the same attorney and the same client on the same subject). Therefore, in applying the waiver, the Board examined each communication to determine whether it involved the same attorney, the same client, and the same subject matter.

The two documents that Prairie Island voluntarily disclosed were letters from Merchant & Gould, the Community's attorney, to Mr. Ronald Valentine, an agent of the Community, discussing trademark availability search results. The Board examined these two letters and applied the limited waiver contained therein to six other communications. The Board determined that Prairie Island waived its privilege to four documents: 1) an April 22, 1992, letter from Merchant & Gould to Foote Marketing Group, an agent of the

Community; 2) a May 13, 1992, letter from Merchant & Gould to Foote Marketing Group; 3) a November 21, 1996, letter from Merchant & Gould to Plaintiff; and 4) a September 13, 1996, letter from Merchant & Gould to Plaintiff.

TIC argues that “[t]he Board’s May 8, 2002, [sic] held that the waiver of the privilege extended to the subject matter of the disclosed documents,” and that “the Board held that the waiver extended to certain subject matter.” See TIC’s September 30<sup>th</sup> Motion at 12. TIC focuses solely on the subject matter component of the waiver standard and elides over the other two criteria: that the communication concerns the same attorney and same client. TIC thereby ignores the plain language of the Board’s Order, holding that “[t]he voluntary waiver by a party, without limitation, of one or more privileged documents discussing a certain subject waives the privilege **as to all communications between the same attorney and the same client on the same subject.**” See Board’s Order at 12 (emphasis added).<sup>1</sup>

TIC disingenuously suggests, by way of explanation, that although the Board’s Order included “numerous references that have held that the waiver extends to communications between the same attorney and the same client on the same subject matter ... this is clearly not the Board’s holding.” See September 30, 2002 Motion at 13. The Board’s Order sets forth the waiver standard in a straightforward and clear manner. It is inconceivable how such a plain statement can be so readily ignored. To support its position, TIC weakly offers that the “remainder of the Board’s order did not indicate that

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<sup>1</sup> In fact, TIC’s argument on “reconsideration” regarding the scope of waiver is broader than its argument in its April 25, 2001 motion papers. See Board’s Order at 11 (the waiver should extend to “all correspondence from Merchant & Gould (plaintiff’s former counsel) regarding the TREASURE ISLAND mark”)(emphasis added).

the waiver was limited to communication between the same attorney and the same client." *Id.*

In examining how the Board applied the waiver standard to the remaining six documents, however, it is apparent that the Board applied the waiver in four instances: each instance concerning communications between the same attorney, the same client, and the same subject matter. Although the Order did not explicitly restate its conclusions or analysis regarding the same attorney and same client components, the clear standard and its application belies TIC's position.

**4. The Board's Waiver Holding Is Limited To Communications With Merchant & Gould Attorney Gregory Sebald And Does Not Extend To Communications With Other Attorneys.**

The April 15, 1992, and the April 22, 1992, letters from Merchant & Gould to Mr. Valentine, the Community's agent, were copied to William Hardacker. The Registrant argues that any waiver of privilege extends to communications among Merchant & Gould, Prairie Island, and William Hardacker because the voluntarily disclosed communications were copied to Mr. Hardacker. Although far from clear, the Defendant apparently argues that Mr. Hardacker's receipt of the communications makes him a party, as an attorney, to the communication and thus, "the waiver certainly extends to communications between Prairie Island and Hardacker." *See* September 30<sup>th</sup> Motion at 13. The Registrant, however, offers the Board no support for this supposition.

The Registrant continues to ignore the plain language of the Board's Order and misapprehends the relationships among Merchant & Gould, the Community, and Mr. Hardacker. First, the Board's Order clearly established that the scope of waiver was limited to communications between Merchant & Gould and the Community (or its agent).

The Registrant's attempt to substitute Mr. Hardacker for Merchant & Gould ignores the Board's holding that waiver is limited to communications with the same attorney. Any attempt to substitute one attorney for another is clearly unwarranted and contrary to the Board's Order.

Mr. Hardacker's role in receiving copies of the 1992 letters was as an agent of the Community. The attorney-client privilege addressed in the 1992 letters concerned Merchant & Gould's advice to the Community, not Mr. Hardacker's advice to the Community. TIC attempts to recharacterize Mr. Haracker's participation in the 1992 letters from his agent role to one supporting a waiver for all communications between Mr. Hardacker, as an attorney, and the Community, as his client. Mr. Hardacker was not acting as an attorney with regards to the 1992 letters; rather, he was acting as the Community's agent. Therefore, the Board's waiver applies only to communications with Merchant & Gould, not other attorneys and any attempts to extend that holding are unsupported.

**5. TIC's claim to additional instances of waiver is without merit.**

At pages 15 – 16 of its brief, TIC argues, apparently, that the Board should redefine its Order in light of alleged additional instances of waiver by the Community. TIC's arguments should be rejected because the alleged instances are irrelevant to and are improperly raised as a basis for reconsideration of a prior Order, rather than as a separate Motion. Moreover, the alleged instances of additional waiver are nothing of the sort, and TIC's arguments to the contrary are inconsistent with the Board's ruling and relevant common law regarding waivers of privilege.

- a. The alleged instances of additional waiver should be the subject of a separate motion and are not properly used to address prior Board Order.**

As a preliminary matter, TIC's arguments regarding additional instances of waiver are improperly asserted in a motion for reconsideration rather than as a separate motion. If the general statements identified by TIC constitute additional instances of a waiver of the attorney/client privilege, TIC should bring a separate motion, and prove the waiver. These alleged additional instances of waiver provide no basis to revisit the Board's Order, which related to an entirely separate disclosure, subject matter and potentially attorney. TIC does not explain in its brief on what basis the Board should consider unrelated subsequent statements to "define" a prior Order of the Board on a distinct waiver. Nevertheless, if TIC believes that the general statements it has identified constitute a waiver of attorney/client privilege on between the parties to the communication and on the subject of the communications, it should bring a motion to that effect.

- b. TIC's alleged instances of additional waiver are entirely without merit.**

TIC's alleged instances of additional waiver of attorney/client privilege are nothing of the sort. While it should go without saying, in order for a waiver of attorney client privilege to exist, there must first be a protectable communication that is confidential, either because it contains the professional advice from an attorney to a person who can act on it or the giving of confidential information to the attorney to enable her to give sound and informed advice. *Swidler & Berlin v. United States*, 524 U.S. 399, 188 S.Ct. 2081 (1998). Further, once the privilege has been waived regarding a communication, the confidentiality of the communication is lost and subsequent

disclosure or discussion of the same communication subject does not constitute an additional instance of waiver. *United States v. El Paso Co.*, 682 F.2d 530, 539 (5<sup>th</sup> Cir. 1982)(stating that the need to cloak confidential communications with secrecy ends when the secrets passes to others); see also 3 *Weinseitr's Federal Evidence* § 503.15, at 503-57. TIC offers four statements -- taken from the Community's answers to Interrogatory No. 6(f) relating to the Community's actions to protect its rights vis a vis TIC<sup>2</sup> -- that it alleges indicate an additional waiver. The four statements are:

1. The Community directed its attorneys to contact the Registrant or its representatives regarding the Treasure Island Las Vegas Project.
2. Merchant & Gould undertook a watching service to monitor any attempt by the Las Vegas concern to acquire federal trademark registrations.
3. Merchant & Gould undertook a watching service to monitor the status of the federal registration for the mark Saint Maarten registration.
4. Merchant & Gould failed to advise the Community that the Saint Maarten registration had lapsed.

The first statement, about what the Community believed it had instructed its attorneys to do in the early 1990, is based on the testimony of a former tribal Council member, and contains no privileged information. The second and third statements regard a matter to which the privilege previously had been waived. The final statement relates to the fact that the Community had NOT received a protectable communication from its former intellectual property counsel regarding the lapse of the Saint Maarten mark, and discloses nothing that is privileged or protectable.

The first statement is based on the deposition testimony of former Tribal Council member Freeman Johnson in which he recalled directing the Community's attorneys to

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<sup>2</sup> The answer, from which TIC takes its excerpts was provided subject to ongoing objections regarding

contact the Registrant regarding the Las Vegas project. This statement has nothing whatever to say about the content of an otherwise privileged communication leading to that direction, whether initiated by counsel or the client, much less whether such an communication even occurred, or who the supposed attorneys were that received such a directive if it was made.

The second and third statements – regarding undertaking a watch service – was in fact disclosed in the April 15, 1992 letter from Merchant & Gould attorney Gergory Sebald to Treasure Island General Manager Ron Valentine and was the subject of the Board's Order. See, Board's Order at 13, referring to document No. 1 (It is noted that the plaintiff did not redact the last paragraph of the third page). TIC Counsel, Mr. McCue, questioned Mr. Sebald regarding that issue at Mr. Sebald's deposition. Trans. p. 32, ll. 8 – 19. It is disingenuous for TIC to now suggest that the Community's statement constitute additional indicia of a waiver of the attorney-client privilege when they have in fact already been the subject of a Board Order.

Finally, TIC alleges that the Community's statement that it failed to receive advice from counsel regarding the lapse of the Saint Maarten mark indicates a waiver of privilege. This statement, again, is a statement of fact regarding a lack of communication and, by its own terms, clearly indicates that there was NO communication, much less a confidential communication, and thus no privileged communication to waive. The Community is entirely at a loss to understand how a statement that there was a lack of advice could constitute a waiver of privilege attaching to the non-existent advice.

It is unclear what relevance TIC attaches to these statements in the context of a request to reconsider an unrelated Board Order. However, it is clear that the four general

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interrogatories seeking the disclosure of information that is protected by the attorney/client privilege.

statements do not disclose the content of otherwise confidential communication between the Community and any of its attorneys and, so, they do not demonstrate additional instances of a waiver of the attorney/client privilege. TIC's motion in this regard, should be rejected.

**B. TIC'S REQUEST FOR RELIEF REGARDING THE DORSEY & WHITNEY DOCUMENT PRODUCTION SHOULD BE DENIED.**

**1. The relief requested by TIC is beyond the Board's jurisdiction.**

TIC requests relief regarding the production of documents by Dorsey & Whitney pursuant to a subpoena issued by the United States District Court for the District of Minnesota. On August 6, 2002, TIC purported to have "subpoenaed" documents in the possession of Dorsey & Whitney. The "subpoena" sent to Dorsey & Whitney purported to have been issued under the jurisdiction of the "Minneapolis Division" of the United States District Court for the District of Minnesota, which does not exist. There further was no District of Minnesota case number assigned. Instead, the "subpoena" identified the case numbers of the pending TTAB proceedings, with the notation that "if action is pending in district other than district of issuance, state district under case number", apparently suggesting that TTAB subpoena authority should be recognized in the District of Minnesota. However, the TTAB has no subpoena authority, Helene Curtis, Inc. v. Derma-Cure, Inc., 1991 TTAB Lexis 457 at p. 7; Luehmann v. Kwik Kopy Corp., 2 U.S.P.Q.2d 1303, 1987 TTAB Lexis 77 at p. 5, n. 3, and the process for securing the attendance of third parties who are not willing to appear voluntarily is plainly set forth in the TBMP. Rule 404.03(b)(2) of the Trademark Trial and Appeal Board Manual of Practice and 37 C.F.R. 2.120(b) provide that "[i]f the proposed deponent is not willing to

appear voluntarily, the deposing party must secure the deponent's attendance by subpoena, pursuant to 35 U.S.C. §24 and FRCP 45. The subpoena must be issued from the United States District Court in the Federal judicial district where the deponent resides or is regularly employed."

On August 12, 2002, and again on August 15, 2002, Dorsey & Whitney attorney William Wernz, former Director of the Minnesota Lawyer's Board of Professional Responsibility, wrote to counsel for TIC and identified the defects with the supposed subpoena sent by counsel for TIC. Dorsey & Whitney was under no obligation to respond to the "subpoena" TIC sent to it, nor was it permitted under Rule 1.6 of the Minnesota Rules of Professional Conduct to disclose privileged or confidential client information unless authorized to do so by the client or required to do so by law or Court Order.

Finally, on August 26, 2002, TIC served on Dorsey & Whitney a valid subpoena that had been issued pursuant to the direction of Rule 404.03(b)(2). September 19, 2002, Dorsey & Whitney complied with the subpoena and produced all responsive, non-privileged or immune documents and provided a log of documents not produced under a claim of attorney/client privilege and/or attorney work product immunity. TIC now seeks relief from the Board regarding Dorsey & Whitney's production, which the Board lacks the jurisdiction to grant. It should be noted that TIC has not sought relief from the United States District Court for the District of Minnesota. Whatever TIC's claims are with respect to the Dorsey & Whitney production, the proper forum for resolving that dispute would be the United States District Court for the District of Minnesota, not this Board.

Accordingly, TIC's motion as it relates to the production of Dorsey & Whitney is not proper because it seeks relief that this Board is without jurisdiction to grant.

**2. TIC's Allegations Regarding The Dorsey & Whitney Production Are Without Merit.**

Though the Dorsey & Whitney document production is beyond the Board's jurisdiction, the Board should note that TIC's speculations and allegations regarding that production are without merit. First, TIC suggests that Dorsey & Whitney should be compelled to produce documents withheld under an assertion of the attorney/client privilege. This argument, in addition to ignoring the fact that the propriety of the production is subject to federal court review, relies on a misguided interpretation of the Board's unequivocal Order regarding the scope of the waiver in this matter. By its plain language, the Community's waiver does not extend to any communication with Dorsey & Whitney. Accordingly, TIC's allegations regarding the production of privileged documents in the possession of Dorsey & Whitney is utterly without merit.

Second, TIC speculates regarding Dorsey & Whitney's assertion of the attorney work product immunity. Its only argument in this regard is that "from a temporal point of view, the Dorsey & Whitney documents cannot be considered to have been created in anticipation of litigation". While that may be TIC's "temporal point of view" of the matter, the fact remains that the attorney work product immunity was properly asserted as to all documents identified in the production privilege log, and if TIC wishes to look behind that assertion, the appropriate forum for that review is Federal Court.

**C. TIC'S REQUEST FOR RELIEF REGARDING THE HARDACKER DEPOSITION SHOULD BE DENIED.**

**1. The relief requested by TIC is beyond the Board's jurisdiction.**

TIC seeks relief regarding the deposition of William Hardacker that is beyond the Board's jurisdiction to grant. In June 28, 2002, TIC purported to have "subpoenaed William Hardacker for deposition". The "subpoena" sent to Mr. Hardacker, like the one sent initially to Dorsey & Whitney, purported to have been issued under the jurisdiction of the "Minneapolis Division" of the United States District Court for the District of Minnesota, which does not exist. There further was no District of Minnesota case number assigned. Instead, the "subpoena" identified the case numbers of the pending TTAB proceedings, with the notation that "if action is pending in district other than district of issuance, state district under case number," apparently suggesting that TTAB subpoena authority should be recognized in the District of Minnesota. However, the TTAB has no subpoena authority, *Helene Curtis, Inc. v. Derma-Cure, Inc.*, 1991 TTAB Lexis 457 at p. 7; *Luehmann v. Kwik Kopy Corp.*, 2 U.S.P.Q.2d 1303, 1987 TTAB Lexis 77 at p. 5, n. 3, and the process for securing the attendance of third parties who are not willing to appear voluntarily is plainly set forth in the TBMP. Rule 404.03(b)(2) of the Trademark Trial and Appeal Board Manual of Practice and 37 C.F.R. 2.120(b) provide that "[i]f the proposed deponent is not willing to appear voluntarily, the deposing party must secure the deponent's attendance by subpoena, pursuant to 35 U.S.C. §24 and FRCP 45. The subpoena must be issued from the United States District Court in the Federal judicial district where the deponent resides or is regularly employed."

Despite TIC's advice to Mr. Hardacker that he had been "duly subpoenaed" for his deposition, he was, in fact, under no obligation to respond to the purported subpoena TIC sent to him, nor was he permitted under Rule 1.6 of the Minnesota Rules of Professional Conduct to disclose privileged or confidential client information unless authorized to do so by the client or required to do so by law or Court Order.

Finally, on August 16, 2002, TIC secured and served on Mr. Hardacker a valid subpoena that had been issued pursuant to the direction of Rule 404.03(b)(2) and neither the Community nor Mr. Hardacker asserted any objection to his appearing at the deposition that was scheduled for October 25, 2002. However, if there were a disagreement regarding the appearance of Mr. Hardacker pursuant to a Federal Court subpoena, the proper forum for resolving that dispute would be the United States District Court for the District of Minnesota, not this Board. Accordingly, TIC's motion as it relates to the deposition of William Hardacker is not proper because it seeks relief that this Board is without jurisdiction to grant.

**2. The Motion is based on the false premise that either the Community or Hardacker is resisting the deposition that was scheduled for October 25, 2002.**

TIC's motion is also improper because it is based on the false premise that the Community has refused to produce Mr. Hardacker based on an assertion of the attorney-client privilege. As the correspondence between the undersigned and counsel for TIC clearly demonstrates, at no time did the Community assert that Mr. Hardacker was immune from a deposition by virtue of the attorney-client privilege. What the Community did state was that "if you want to take Mr. Hardacker's deposition, I suggest that you secure a valid subpoena." Pursuant to Rule 404.03(b)(2) of the TBMP, Mr.

Hardacker must be subpoenaed if he was unwilling to appear voluntarily for a deposition, and such a subpoena must issue from the United States District Court where he resides, in this case the District of Minnesota, not from the law offices of Quirk & Tratos. The Community further pointed out that Mr. Hardacker was not permitted under Rule 1.6 of the Minnesota Rules of Professional Conduct to disclose sensitive client information without the client's consent or a court order, neither of which existed at the time.

After serving the invalid subpoena on Mr. Hardacker and receiving his objection to it, TIC counsel wrote to Mr. Hardacker advising him, incorrectly, that he had been "duly subpoenaed" and was required to appear for his deposition. That advice was simply false. Nevertheless, TIC counsel finally secured a valid Federal Court subpoena and served it on Mr. Hardacker. Neither the Community nor Mr. Hardacker have asserted any objection to his appearance at the deposition that was scheduled for October 25, 2002, which was the indisputable status of the matter at the time when TIC filed the instant motion. Accordingly, TIC's request for Board relief on the issue of Mr. Hardacker's deposition should be denied, because the assertion that the Community or Mr. Hardacker are refusing to appear on October 25, 2002 is untrue.

### **3. TIC's Motion is moot.**

TIC's Motion also must be denied as moot. After finally securing and serving on Mr. Hardacker a valid subpoena, and after filing the instant motion requesting Board relief on the matter, counsel for TIC postponed indefinitely the deposition of Mr. Hardacker one day before it was to occur. Accordingly, not only is there no dispute regarding the Community's willingness to produce Mr. Hardacker for a deposition, there is no scheduled deposition at which to present him. The matter is, therefore moot.

**D. TIC'S MOTION FOR EXTENSION OF DISCOVERY IS IMPROPER  
SINCE THE PARTIES HAVE NOT BEEN UNSUCCESSFUL IN  
ADDRESSING DISCOVERY DEADLINES.**

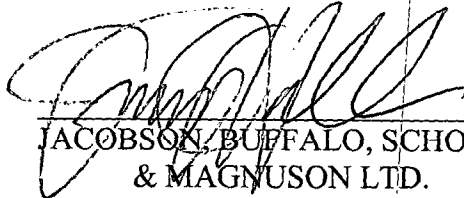
TIC also requests a Board Order extending discovery in this matter. This request is improperly before the Board, since the Community had not objected to any extension and in fact, had discussed a stipulation to that effect in a telephone conversation with attorney McCue just days before TIC filed the instant motion. As a result, this request is improper, since the parties have not reached an impasse on the matter and, to the contrary, could have stipulated to the relief TIC now seeks.

#### IV. CONCLUSION

For the foregoing reasons, the Community respectfully requests an order of this Board denying the relief requested in TIC's Motion. The requests are either improperly before this Board, are without merit, or both.

Respectfully submitted,

Date: November 4, 2002



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**IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE BEFORE THE TRADEMARK  
TRIAL AND APPEAL BOARD**

Prairie Island Indian Community,  
a federally recognized Indian Tribe,

Petitioner

vs.

Treasure Island Corporation,

Registrant.

Reg. Nos. 1,949,380; 1955,279  
2,010,396; 2,176,004; 1,984,421  
2,040,221; 2,019,481; 1,918,033  
1,941,475; 1,966,090; 1,903,619  
1,943,123; 1,949,379; 1,985,968  
2,040,756; 2,040,770; 1,981,369

Can. Nos. 28,126; 28,127; 28,130  
28,133; 28,145; 28,155; 28,199  
28,248; 28,280; 28,294; 28,314  
28,319; 28,325; 28,342; 28,379  
28,171; 28,174  
Opposition No. 115,866

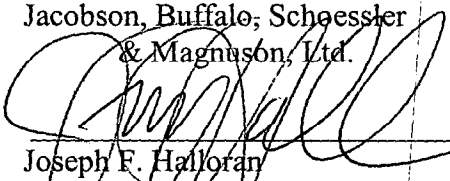
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, VA 22202-3513

CERTIFICATE OF MAILING VIA EXPRESS MAIL: November 4, 2002

Sir:

I hereby certify that the original and three copies of the attached: PETITIONER'S RESPONSE TO MOTION TO COMPEL PRODUCTION OF DOCUMENTS, TO DEFINE SCOPE OF THE WAIVER OF ATTORNEY CLIENT PRIVILEGE AND TO EXTEND DISCOVERY, in connection with the above-identified matter are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to BOX TTAB, Trademark Trial and Appeal Board, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, under Express Mail Label No. ET033373858US on November 4, 2002.

Respectfully submitted,  
Jacobson, Buffalo, Schoessler  
& Magnuson, Ltd.

  
\_\_\_\_\_  
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**IN THE UNITED STATES PATENT AND  
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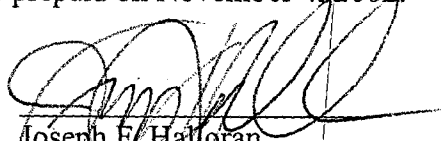
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Opposition No. 115,866

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing: PETITIONER'S RESPONSE TO MOTION TO COMPEL PRODUCTION OF DOCUMENTS, TO DEFINE SCOPE OF THE WAIVER OF ATTORNEY CLIENT PRIVILEGE AND TO EXTEND DISCOVERY was served on Treasure Island Corp., c/o Michael McCue, of Quirk & Tratos, 3773 Howard Hughes Parkway, Suite 500 North, Las Vegas, NV 89109, Attorney for Respondent, via first class mail, postage prepaid on November 4, 2002.

Dated: November 4, 2002

  
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Attorney(s) for Petitioner  
Prairie Island Indian Community  
a Federally Recognized Indian Tribe

TTAB

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TRADEMARK TRIAL AND  
APPEAL BOARD

IN THE UNITED STATES PATENT AND  
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LETTER

November 4, 2002

Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Dear Trademark Trial and Appeal Board:

Enclosed herewith for filing are the following documents:

DD

Trademark Trial and Appeal Board

November 4, 2002

Page 2

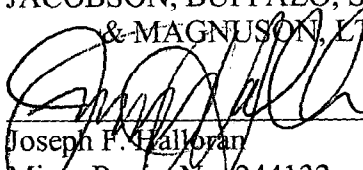
1. The original and two copies of the Petitioner's Response to Motion to Compel Production of Documents, to Define Scope of the Waiver of Attorney Client Privilege and to Extend Discovery;
2. Certificate of Service on Treasure Island Corporation/Michael J. McCue; and
3. Express Mail Certificate Under No. ET033373858US.

Please feel free to contact the undersigned with any questions regarding this filing, and thank you for your kind assistance.

Respectfully submitted,

JACOBSON, BUFFALO, SCHOESSLER  
& MAGNUSON, LTD.

Date: 11/4/02

  
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